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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,735	07/02/2001	David Guedalia	4529/83200	8182

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EXAMINER

CASIANO, ANGEL L

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>09/897,735</p>	<p>Applicant(s)</p> <p>GUEDALIA ET AL.</p>	
	<p>Examiner</p> <p>Angel L Casiano</p>	<p>Art Unit</p> <p>2182</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20020313</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The present Office action is in response to application dated 02 July 2001.

Claims 1-29 are pending. All claims have been examined.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 13 March 2002 was filed after the mailing date of the application on 02 July 2001. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 1, it recites “enabling a thin client”, in order to “employ a presence server for initiating communications channel between at least first and second instant messaging users”. Examiner respectfully submits that it is unclear whether the claimed “thin client” is associated, used, or constitutes itself the “first” and/or “second” IM users.

6. Claim 5 recites the limitation "redirecting at least one client" in reference to claim 1. However, claim 1 recites “a thin client” and “first and second” users, not multiple *clients*. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 2-8 depend either directly or indirectly upon claim 1 and are therefore rejected under the same basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

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patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-7, 11-18, 21-22, 25, and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Mendiola et al. [US 2002/0006803 A1].

Regarding claim 1, Mendiola et al. teaches a method for instant messaging (see “Title”, “Abstract”) enabling a thin client (see “mobile phone”; Page 1, [0001-0002]) to employ a server (see “server”; Page 2, [0028-0035]) for initiating a communication channel between at least first and second instant messaging users (see Page 2, [0019]); and conducting instant messaging along said communication channel between said instant messaging users (see Page 2, [0028, 0029]).

As for claim 2, Mendiola et al. teaches a server for simplifying client-side connection negotiations to initiate the communication channel (see Abstract; Page 2, [0019], “quickly and efficiently”).

As per claim 3, Mendiola et al. teaches enabling non-persistent clients (see “mobile phones”, Page 1, [0001-0002]) to maintain a session along the communication channel (see Page 2, [0031]; Page 7, [0124]).

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As per claim 4, Mendiola et al. teaches enabling non-persistent clients (see “mobile phones”, Page 1, [0001-0002]) to maintain a session along the communication channel (see Page 2, [0031]; Page 7, [0124]).

As for claims 5-7, Mendiola et al. teaches directing a client to a previously opened session at a server (see Page 3, [0048], “prospective user invited to register by an existing user”; Page 7, [0124]).

Regarding claim 11, Mendiola et al. teaches a system for instant messaging (see “Title”, “Abstract”; Figures 1-5) enabling a thin client (see “mobile phone”; Page 1, [0001-0002]) to employ a server (see “server”; Page 2, [0028-0035]) for initiating a communication channel between at least first and second instant messaging users (see Page 2, [0019]); and conducting instant messaging along said communication channel between said instant messaging users (see Page 2, [0028, 0029]). The prior art also specifies a server (see Figure 3, “89”) having a “registration handler”, (element “96”).

As for claim 12, Mendiola et al. teaches a system for simplifying client-side connection negotiations to initiate the communication channel (see Abstract; Page 2, [0019], “quickly and efficiently”).

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As per claims 13-14, Mendiola et al. teaches a system for enabling non-persistent clients (see “mobile phones”, Page 1, [0001-0002]) to maintain a session along the communication channel (see Page 2, [0031]; Page 7, [0124]).

As per claims 15-16, Mendiola et al. teaches communication protocol for communication between the server and first and second communication devices (see “GSM”, “SMS”, Page 1, [0013-0014]).

As per claims 17-18, Mendiola et al. teaches a system implementing the step of directing a client to a previously opened session at a server (see Page 3, [0048], “prospective user invited to register by an existing user”; Page 7, [0124]).

As for claim 21, Mendiola et al. teaches users using Global System for Mobile communication (“GSM”) networks (see page 1, [0002]). The reference does not mention a WAP client. However, WAP supports GSM and HTML.

As for claim 22, Mendiola et al. teaches a server having session information (see Figure 3, “89”, “96”; Page 2, [0031]).

As for claim 25, Mendiola et al. teaches account information for validating user access (see Page 2, [0033-35]).

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As for claim 28, Mendiola et al. teaches users using Global System for Mobile communication ("GSM") networks (see page 1, [0002]). The reference does not mention a WAP client. However, WAP supports GSM and HTML. In addition, the prior art shows a GSM server in communication with the IM server (see Figure 1, "15", "19").

As for claim 29, Mendiola et al. teaches and external server for communication between an IM service and server (see Figure 4).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendiola et al. [US 2002/0006803 A1] in view of Ramasubramani et al. [US 6,507,589 B1].

As for claims 8-10, Mendiola et al. teaches clients having IM applications of different types (see Page 2, [0019]; Page 3, [0042]). However, the cited art does not explicitly teach a "first

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communication protocol” between first user and presence server or a “second communication protocol”, which is “different from said first communication protocol” between server and second user. That is, the prior art does not expressly disclose the first and second users communicating to the server using different protocols. Regarding this limitation, Ramasubramani et al. teaches “various mobile device” of “different type”. Nonetheless, Ramasubramani et al. does teach communication with a server using different protocols (see Abstract; column 1, line 35; column 2, lines 63-67). Accordingly, at the time of the invention one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to obtain a method capable of routing messages, from mobile devices using different protocols.

As per claims 19-20, Mendiola et al. teaches a system in which clients have IM applications of different types (see Page 2, [0019]; Page 3, [0042]). However, the cited system does not explicitly teach a “first communication protocol” as being different from a “second communication protocol”. Regarding this limitation, Ramasubramani et al. teaches “various mobile device” of “different type”. In addition, Ramasubramani et al. does teach communication with a server using different protocols (see Abstract; column 1, line 35; column 2, lines 63-67). Accordingly, at the time of the invention one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to obtain a method capable of routing messages, from mobile devices using different protocols.

12. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendiola et al. [US 2002/0006803 A1] in view of Ball et al. [US 2002/0126135 A1].

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As for claim 23, Mendiola et al. does not explicitly teach an “audio file server” associated with a “presence server”. Regarding this limitation, Ball et al. (see [0243] and [0250]) teaches a server for audio files. Accordingly, one of ordinary skill in the art at the time of the invention would have been motivated to combine the cited disclosures in order to transmit audio files from a network server to a mobile client “efficiently” and “accurately” (see Ball et al.).

13. Claims 24 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendiola et al. [US 2002/0006803 A1] in view of Philonenko [US 20020131399 A1].

As for claims 24 and 26, Mendiola et al. does not teach an IVR operative to interface between a telephone and a presence server. Regarding this limitation, Philonenko teaches applying an IVR for instant messaging communication events (see Page 2, [0023], [0029]). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to implement a communication events processing method (see Philonenko). The combination of references would have provided communication (IM) routing.

As for claim 27, Mendiola et al. teaches a message cache (see Page 1, [0013]).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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- Lamb et al. [US 6,747,970 B1] teaches method and apparatus for providing communication services.
- Carey et al. [US 6,714,793 B1] teaches method and system for IM across cellular networks.
- Tang et al. [US 2002/0101446 A1] teaches system and method for device interaction.
- Aravamudan et al. [US 6,301,609 B1] teaches assignable associate priorities for user-definable IM buddy groups.
- Shaffer et al. [US 5,911,123] teaches system and method for wireless connections.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L Casiano whose telephone number is 703-305-8301 (after **October 12, 2004**, this will change to **(571) 272-4142**). The examiner can be reached during office hours 9:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 (**(571) 273-4142**, after **October 12, 2004**).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alc
September 10, 2004.



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SUPERVISORY PATENT EXAMINER
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